

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte RICHARD P. METTKE

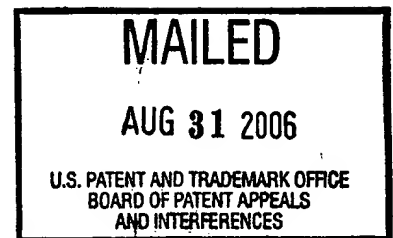
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Appeal No. 2006-0625  
Reissue Application 09/134,831

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ON BRIEF

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Before BARRETT, LEE, and MEDLEY, Administrative Patent Judges.  
BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the final rejection of claims 6-9. Claims 1-5 have been canceled.

We affirm, but also enter new grounds of rejection.

REISSUE and PROTESTS

This application was filed on August 17, 1998, for reissue of U.S. Patent No. 5,602,905 (the '905 patent), entitled "On-Line Communication Terminal/Apparatus," by inventor Richard P. Mettke, issued February 11, 1997, based on Application 08/376,247, filed January 23, 1995. The reissue declaration by inventor/Patent Owner Richard Mettke states that he believes the patent to be wholly or partly inoperative or invalid by reason of claiming less than he had a right to claim, in particular, because he removed the word "Internet" from the specification and the claims without submitting additional claims directed to an online communications terminal for accessing the Internet.

Protests were filed under 37 CFR § 1.291(a) by: (1) TouchNet Information Systems, Inc. on November 4, 1998; (2) North Communications, Inc. on March 31, 1999; and (3) Griffes Consulting, SA on August 11, 1999.

LITIGATION

Mettke v. Hewlett Packard, Co. and North Communications, Inc., No. CV-97-TMP-3160-E (N.D. Ala. filed December 8, 1997), dismissed with prejudice by Order entered December 8, 1999.

Mettke v. TouchNet Information Systems, Inc., No. CV-98-PT-0596-E (N.D. Ala. filed March 16, 1998), dismissed with prejudice by Order entered September 21, 1998.

BACKGROUND

The invention relates to a pay-as-you-use public terminal for accessing the Internet. The original application, as filed, disclosed a public terminal for accessing online service providers (such as Prodigy and CompuServe) and Internet providers, but all but three references to the Internet were canceled. The stated purpose of this reissue is to correct Patent Owner's error in deleting references to the Internet and claims to a pay-as-you-use terminal for accessing the Internet. The background of the invention in Application 08/376,247, as originally filed, describes (page 2):

In the past few years there has been a remarkable growth in the use of commercial on-line service providers (I.E. PRODIGY, COMPUSERVE, AMERICAN ON-LINE, and DELPHI), Internet providers and use of FAX machines. The use of the above listed services are normally conducted in the home or office.

Many businesses use E-mail (through an on-line service or the Internet) to conduct day to day operations . . . . In addition, businesses constantly draw from the wealth of data bases of information available from the on-line services and the Internet.

Commercial and Internet on-line members also access the services for personal and leisure activities . . . . These services are generally accessed from fixed site locations at home or in the office. Although, portable terminals (lap top computers) with modems are available; they are often cumbersome and are not user friendly for a travelling business people or other users of on-line services or the Internet on the road.

The current pay as you use FAX machine requires users to have a hard copy document to send; and virtually none are able to receive in a user friendly configuration. In many situations, it is impractical for a user to have a hard copy document in hand to send. This invention will allow a user to create a document on screen and FAX it out, as well as provide for a header and print out a copy of the message sent. A telephone will also be located in the terminal cubicle to instruct the sender to transmit a FAX to the terminal location.

An added feature of the terminal would allow for minor word processing at its terminal. This would be a highly desirable service for business people/individuals on the go that would require its service. . . .

After listing prior art patents, the background concludes

(page 4):

Accordingly, there is no one device/apparatus that allows a user, to access, on a pay as use basis, such an array of one stop applications. The terminals would be located in such diverse locations as airports, hotels, business centers, libraries, hospitals, shopping malls and other locations as appropriate.

The object and advantages of the invention are described as follows (page 4):

Accordingly, besides the objects and advantages of this device/apparatus described previously in my patent, several objects and advantages are (some restated):

(a) Users can conveniently access commercial on-line services and the Internet at other locations other than from their fixed terminal at an office or home.

(b) Users can create, send and receive FAX's from the terminal.

(c) Users can conduct word processing operations and send the file via e-mail to another fixed terminal.

(d) Users can receive a hard copy document from a laser printer of any activity that they conduct at the terminal.

(e) Users will pay for the use of the terminal using a credit card swipe apparatus. The user will be charged for use of the terminal, telephone line use charges and additional charges by the commercial on-line service or Internet provider.

(f) Commercial on-line services and Internet providers will benefit greatly by the additional exposure/access of their services.

(g) Users will have the convenience of having easy access to the services provided by the terminal at a reasonable price; negating the need for frequent travelers to unnecessarily carry around a cumbersome laptop terminal with accessories for FAX'ing or conducting other on-line activities.

The apparatus is a "[t]erminal device which is comprised of the monitor, keyboard w/mouse, central processing unit w/internal modem (14.4 -28 BPS), integrating software, laser printer, credit

card swiping device, telephone and telephone lines" ('905 patent, col. 2, lines 42-46), as represented by block 2 in Fig. 1.

Figure 2, as originally filed, is reproduced below.

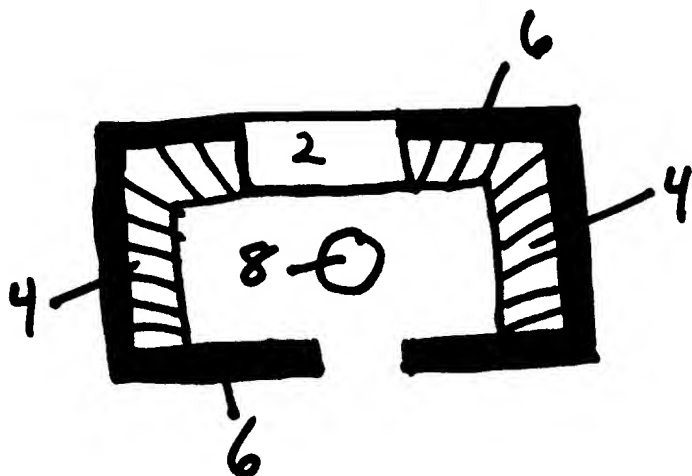


Figure 2 shows a top view of a cubicle surrounded by a wall 6 and having a desk top 4 holding the terminal 2 with a round stool 8 in front of the terminal. Patent Owner filed a substitute Fig. 2 showing the terminal in the form of a housing containing the terminal components, which the Examiner accepted and which became Fig. 2 of the '905 patent. The same Examiner in this application now has objected to Fig. 2 as new matter and has required that it be restored to the original figure (Final Rejection, p. 2).

Patent Owner responded (Amendment of April 24, 2002): "It would be obvious to some one skilled in the art that the words and meanings of 'terminal' and 'housing' are synonymous as portrayed

in the original disclosure. In, [sic] addition the prior art provided, demonstrates this contention. Where else would the components listed in the specification be housed?" (Emphasis omitted.) The Board has no jurisdiction to review "objections" to the disclosure under 35 U.S.C. § 132; the Board's jurisdiction is limited to those matters involving the rejection of claims. In re Hengehold, 440 F.2d 1395, 1404, 169 USPQ 473, 480 (CCPA 1971). Nevertheless, since Patent Owner is pro se, we note that the Examiner is correct because the original Fig. 2, as filed, did not show the components arranged in a unitary housing as in the substitute Fig. 2. The fact that references cited in the patent disclose components in a housing does not disclose that Patent Owner's components are in a housing. A "terminal device" does not imply a unitary housing, the various components of CPU, display, keyboard, printer, etc. can be separate components on a desk as with most home computers. The patent law is very strict about new matter in the specification and claims. A claim to a housing would properly be rejected for lack of written description since what would have been obvious is not the test for written description. See Lockwood v. American Airlines Inc., 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1968 (Fed. Cir. 1997) ("One shows that one is 'in possession' of the invention by describing the invention, with all of its claimed limitations, not that

which makes it obvious." ). Patent Owner has properly canceled references to a "housing" in claim 6.

Claims 6-9 are reproduced below.

6. A public on-line, pay-as-you-use communications terminal comprising:

a central processing unit (CPU);

a telephone access node;

an internal modem coupled to the CPU and telephone access node;

a video display monitor coupled to the CPU;

a keyboard for providing user interface coupled to the CPU;

a credit card reader swipe device coupled to the CPU for accepting payment by a user for use of the terminal;

means for accessing the Internet and allow for user interaction;

software installed into the CPU to allow interface with the Internet and credit card service centers; and

a printer coupled to the CPU.

7. The terminal of claim 6, wherein the means for accessing includes a keyboard which communicates with and controls a microprocessor.

8. The terminal in accordance with claim 6 also including program means for causing said printer to print a receipt or any other document available from a commercial on-line service.

9. The terminal of claim 6, wherein the terminal comprises a CPU, monitor, credit card reader swipe device, internal modem and printer.



#### THE REFERENCES

The examiner relies on the following references:

Allen Weiner, TouchFax Provides the Ultimate In Place-Based Interactivity, Interactive World (October 1992), pp. 48-49 (Exhibit E to TouchNet Protest).

VISION . . . POWER . . . VERSATILITY, F700 Public Communications Terminal brochure, TouchFax Information Systems, Inc. (© 1991) (Exhibit F to TouchNet Protest).

Rawn Shah, Suggestions for Information Kiosk using the World Wide Web, <http://www.rtd.com/people/rawn/kiosk-paper.html> (April 30, 1994), download date 2/3/99, pp. 1-5 (Exhibit I to Protest by North Communications, Inc.) (hereinafter "Shah").

The World Wide Web Conferences, 1994-1995 Kiosk Papers, <http://www.visi.com/~keefner/pdfs/twwwc.htm>, pp. 1-3 (of 113) (hereinafter the "1994-1995 Kiosk Papers") (not prior art).

#### THE REJECTIONS

We refer to the Final Rejection (pages referred to as "FR\_\_") entered March 12, 2002, and the Examiner's Answer (pages referred to as "EA\_\_") entered August 17, 2005, for a statement of the Examiner's rejection, and to the Revised Appeal Brief (pages referred to as "Br\_\_") filed March 20, 2005, for a statement of Patent Owner's arguments thereagainst.

Dependent claim 7 stands rejected under 35 U.S.C. § 112, first paragraph, based on lack of written description for the limitations that a keyboard "controls a microprocessor" and for a "microprocessor" in addition to the claimed CPU.

Claims 6-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Exhibit E, Exhibit F, and Shah. The 1994-1995 Kiosk Papers article is cited to show that Shah was publicly accessible at the time of filing and, therefore, a prior art "printed publication." The Examiner finds that one difference between the subject matter of claim 6 and Exhibit E is that Exhibit E does not expressly disclose software to allow interaction with credit card centers (FR6). The Examiner finds that Exhibit F teaches the use of software to carry out communication functions and concludes that it would have been obvious to use software "within the TouchFax terminal of Exhibit E to carry out its communication functions with the credit card centers in order to authorize payments made via the credit card reader" (FR6). The Examiner finds that the difference between the subject matter of claim 6 and the combination of Exhibits E and F is that Exhibits E and F do not specify accessing and interfacing with the Internet (FR6). The Examiner finds that Shah teaches the desirability of providing access to the Internet in a kiosk-based information system to provide users with the many services on the Internet and concludes that "[i]t would have been obvious to an artisan of ordinary skill to incorporate such means for accessing and software for interfacing with the Internet in a kiosk information

system, as taught by the Shah article, within the combination of Exhibits E and F in order to provide users with access to the many services available on the Internet" (FR7).

#### DISCUSSION

##### Attachments

For convenience, a copy of the references and other documents mentioned are attached to this opinion, except for the videotape Exhibit C.

##### Written description

The written description requirement of 35 U.S.C. § 112, first paragraph, is used to reject when a claim is added or amended to recite a limitation without support in the original disclosure. See In re Rasmussen, 650 F.2d 1212, 1214-15, 211 USPQ 323, 326 (CCPA 1981). The specification must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. See Vas-Cath Inc. v. Mehurkar, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991). Satisfaction of the written description requirement does not require the description to be in ipsis verbis (in the identical words) antecedence in the originally filed application. See In re Lukach, 442 F.2d 967, 969, 169 USPQ 795, 796 (CCPA 1971).

Initially, it is noted that Patent Owner proposed canceling claim 7 (in response to the § 112 rejection) and claim 9 (in response to an objection that it was in improper dependent form for failing to further limit the subject matter of claim 6) by the amendment after final rejection received April 24, 2002, but the Examiner denied entry of the amendment.

The Examiner finds that the added limitation, "a keyboard which communicates with and controls a microprocessor," is not supported by the original disclosure because it makes no mention of the keyboard controlling a microprocessor (FR4).

Patent Owner refers (Br6-7) to the description of U.S. Patent 4,374,381 in the list of prior art in the '905 patent, which states "[a] touch terminal which communicates and controls a microprocessor" ('905 patent, col. 1, lines 43-44).

The Examiner responds that the original disclosure does not describe the keyboard controlling a microprocessor, because "[c]ommunication and control are two different functions" (EA7).

We will not sustain this reason for the rejection. Although a description of prior art is not a written description of the invention, the original disclosure does describe a keyboard connected to the CPU. One of ordinary skill in the art would find it inherent that a keyboard controls a CPU by causing it to

perform functions entered by the keystrokes. No new function is introduced.

The Examiner also finds that there is no provision in the original disclosure for a "microprocessor" in addition to the CPU already recited in claim 6.

Patent Owner does not respond to this reason.

We agree with the examiner that the disclosure does not discuss both a CPU and a microprocessor. Nor is it clear that the "microprocessor" and the "CPU" are intended to refer to the same thing. Because of the use of the indefinite article "a" in "a keyboard," it is not even clear that the keyboard is the keyboard

in claim 6.<sup>1</sup> This appears to be a misuse of terminology by Patent Owner, but, nevertheless, the limitation, as presented, is not supported.

The written description rejection of claim 7 is sustained.

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<sup>1</sup> Since Patent Owner is pro se, we explain that, as a matter of claim draftsmanship, the first time an element is introduced it is referred to using the indefinite article "a" or "an," and when later referring back to a previously mentioned element, it is referred to using a definite article, such as "the" or "said," so that readers know that it refers to the previous element. When an element is introduced the first time using a definite article, the claim is usually rejected under 35 U.S.C. § 112, second paragraph, as indefinite for "lack of antecedent basis."

The references are prior art "printed publications"

Patent owner argues that Exhibit E, Exhibit F and Shah are not prior art.

Whether a reference is prior art under 35 U.S.C. § 102 is a question of law. See Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1568, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987).

Whether a given reference is a "printed publication" depends on whether it was "publicly accessible" during the prior period.

See In re Wyer, 655 F.2d 221, 226, 210 USPQ 790, 794 (CCPA 1981).

A given reference is "publicly accessible"

upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it and recognize and comprehend therefrom the essentials of the claimed invention without need of further research or experimentation.

Id. (quoting I.C.E. Corp. v. Armco Steel Corp., 250 F. Supp. 738, 743 (S.D.N.Y. 1966)). The requirement of public accessibility can be satisfied under a variety of conditions, including when there has been a meaningful distribution, indexing, or display of the material to the public interested in the art. See generally In re Klopfenstein, 380 F.3d 1345, 72 USPQ2d 1117 (Fed. Cir. 2004).

The original purpose for the "printed" requirement, that printing increases the probability that a reference will be

available to the public, has largely been made redundant by changes in document duplication, data storage, and data-retrieval systems. See Wyer, 655 F.2d at 226, 210 USPQ at 794. "Printed publication" is now addressed as a unitary concept where "the question to be examined under § 102(b) is the accessibility to at least the pertinent part of the public, of a perceptible description of the invention, in whatever form it may have been recorded." Id. "[A] printed document may qualify as a 'publication' under 35 U.S.C. § 102(b), notwithstanding that accessibility thereto is restricted to a 'part of the public,' so long as accessibility is sufficient 'to raise a presumption that the public concerned with the art would know of [the invention].'" In re Bayer, 568 F.2d 1357, 1361, 196 USPQ 670, 674 (CCPA 1978).

A "printed publication" need not actually be seen by anyone; if the document was available and accessible so that a hypothetical person of ordinary skill in the art exercising reasonable diligence could have found it. The document is prior art because of its constructive placement into the public domain. Many of the cases on "printed publication" deal with the question of accessibility to the document by a hypothetical person of ordinary skill; that is, whether there is constructive knowledge by the public. See Bayer (unshelved and uncataloged master's

thesis accessible only to graduate committee prior to critical date not sufficiently accessible to public to constitute a "publication"); Wyer (application microfilmed and diazo copies deposited at five sub-offices of Australian Patent Office constitutes printed publication); In re Hall, 781 F.2d 897, 228 USPQ 453 (Fed. Cir. 1986) (single cataloged doctoral thesis deposited in a library in Germany prior to the critical date was a printed publication as of that date); In re Cronyn, 890 F.2d 1158, 13 USPQ2d 1070 (Fed. Cir. 1989) (undergraduate thesis deposited in college library open to the public but neither cataloged nor indexed in meaningful way is not a printed publication because it is not accessible to the public); Bruckelmeyer v. Ground Heaters, Inc., 445 F.3d 1374, 78 USPQ2d 1684 (Fed. Cir. 2006) (two canceled drawings remaining in Canadian patent's file wrapper were printed publications because a person of ordinary skill in the art interested in the subject matter and exercising reasonable diligence would be able to locate them).

#### Exhibit E

Patent Owner argues that Exhibit E appears on its face to be an article in the October 1992 journal entitled "Interactive World," but that he "has been unable to determine where to access 'Interactive World,' or what individuals had access to Exhibit E



at any time prior to the filing date of this application, i.e., January 23, 1995" (Br10). Patent owner argues that a "representative of the appellant searched the catalogs of Rice University and the University of Houston, two of the largest library collections in the fourth largest city in the United States and was unable to locate any journal entitled 'Interactive World'" (Br12) and "submits that Exhibit E is not prior art that can be cited against the claims of this application" (Br12).

The Examiner responds that Exhibit E is an article from the magazine "Interactive World," which is clearly a printed publication (EA7).

The Examiner does not address Patent Owner's arguments. On its face, Exhibit E is a printed magazine article, which is presumed to be distributed and publicly accessible. Nothing about Exhibit E suggests that it is not what it seems or that it was somehow fabricated for purposes of litigation. Patent Owner's statement that his representative was unable to find "Interactive World" in the catalogs of Rice University and the University of Houston is not in the form of an affidavit or declaration, but, in any case, looking in only two libraries is hardly evidence of reasonable diligence. The magazine is clearly a specialized publication that would not be expected to appear in every library. Several years worth of the magazine are in the

U.S. Patent and Trademark Office's (USPTO's) Scientific and Technical Information Center (STIC), although not for the year 1992. An article from the November/December issue of "Internet World" is applied in a new ground of rejection and includes the publication information page. Exhibit E is a prior art "printed publication."

Exhibit F

Patent Owner argues that Exhibit F is not prior art because (Br15):

No evidence has been provided by any of the Protestors or the Examiner as to where Exhibit F can be accessed by the public, or on what date Exhibit F became accessible to the public. Exhibit F may not have been disseminated to anyone outside of Protestor's organization at any time prior to January 23, 1995.

The Examiner responds that Exhibit F is one of a series of product brochures distributed without restriction and was available to the public in March/April of 1991, as evidenced by pages 54-56 of the Deposition of Daniel J. Toughey, President of TouchFax, in Mettke v. TouchNet, No. 98-PT-596-E (EA8).

Patent Owner ignores the evidence of Mr. Toughey's deposition. Exhibit 7 in Mr. Toughey's deposition corresponds to the present Exhibit F. Mr. Toughey testifies that the brochures for Exhibit 7 were distributed and made publicly available in March/April of 1991 (Toughey deposition, p. 55, lines 15-23).

Patent Owner's attorney, who deposed Mr. Toughey, could have asked further questions if there was any doubt as to the distribution of this document. As it stands, there is testimony under oath that the copyright date of 1991 for Exhibit 7 (now Exhibit F) is when the document became publicly accessible and Patent Owner had fair opportunity to challenge this date. To the extent Patent Owner somehow thinks that Exhibit E should be presently cataloged and accessible, we note cataloging in a library is only one of many ways to qualify as a printed publication. Exhibit F was accessible from, at least, TouchNet and, since it was distributed, it was accessible to the part of the public interested in such devices. Once something becomes a printed publication, it does not cease to be a printed publication just because it later may be hard to find a copy. Exhibit F is a prior art "printed publication."

Shah

Patent owner argues that the Shah article is not prior art because the Protestors and Examiner have not provided any evidence that it was accessible to a member of the public exercising reasonable diligence (Br16). It is argued that it appears that Exhibit I was only available on the World Wide Web and was not indexed or cataloged in any library or other location accessible to the public (Br16). It is argued that a person

would have to know the name of the author to have any chance of locating the article using a search engine on the World Wide Web, because any other key terms, such as kiosk and Internet, are too generic, and knowledge of the author of an article is rarely available to the searcher (Br16).

The Examiner responds that the Shah article is mentioned in the 1994-1995 Kiosk Papers document as a paper presented at one of the three World Wide Web conferences in May 1994, October 1994, and April 1995, and its date of April 30, 1994, is consistent with the conference in May 1994 (EA9).

We conclude that the Shah article has sufficient indicia of public dissemination and access to be a prior art publication or, at least, to shift the burden of production of evidence to Patent Owner to show that it is not. The Shah article is formatted and appears on its face to be a final paper prepared for the "World Wide Web Information Kiosks Special Interest Group" that was published, complete with author information and a list of references; it is not just a draft that one would not expect to be published. The Shah article is referred to in the 1994-1995 Kiosk Papers as having been presented at one of the World Wide Web conferences and there is no reason to doubt the truth of this statement by a disinterested third party. We agree with the Examiner that the April 30, 1994, date is consistent with the

First International Conference held May 25-27, 1994, but this is not expressly stated. Nevertheless, by process of elimination it must be one of the first two conferences held in 1994. While the 1993-1994 Kiosk Papers article can still be found on the World Wide Web, "<http://www.visi.com/~keefner/pdfs/twwwc.htm>," most links are expired except for "WWW Spring '95" to "The Third International World-Wide Web Conference," "[http://www.igd.fhg.de/archive/1995\\_www95/](http://www.igd.fhg.de/archive/1995_www95/)." This 1995 Conference Web page has a list of papers and authors and the Shah article is not among them, so we conclude that it must have been presented at one of the two 1994 conferences. In addition, the Shah article was downloaded from a Web site, "<http://www.rtd.com/people/rawn/kiosk-paper.html>" (the same URL noted in the 1994-1995 Kiosk Papers), and an earlier 1994 Shah paper in the references also has a URL, which reasonably suggests that the Shah articles were both publicly available on the Internet as of the date on the article, although not downloaded until 2/3/99. Web pages on the Internet are "printed publications." Patent Owner's argument that Shah would have been impossible to locate on the Internet is mere speculation. There is sufficient indicia to indicate that the Shah paper was publicly accessible at one of the 1994 World Wide Web conferences and on the Internet to shift the burden to Patent Owner to further investigate. See In re Epstein, 32 F.3d 1559,

1570, 31 USPQ2d 1817, 1825 (Fed. Cir. 1994) (Plager, J., concurring) (It is unreasonable "to require the PTO examiners to do any investigation suggested by available information. Since more and more information is now available on computer databases, that could require a staff of investigators far in excess of the resources currently available to the PTO. At bottom, the issue in this case is who is to bear the cost of further investigation when further investigation is thought warranted. The solution agreed to by the panel, and with which I concur, is at least for now to allow the PTO to use its immediately available data sources to identify legitimate questions that need answering, and then to place upon the applicant the burden of finding those answers."). Shah is a prior art "printed publication."

#### Claim interpretation

It is noted that claims 6-9 do not require that the elements be in a housing.

The limitations of claim 6 that require interpretation are "pay-as-you-use" and "payment by a user for use of the terminal."

Claim 6 recites, in relevant part:

6. A public on-line, pay-as-you-use communications terminal comprising:

. . .

a credit card reader swipe device coupled to the CPU for accepting payment by a user for use of the terminal;

means for accessing the Internet and allow for user interaction; . . . .

software installed into the CPU to allow interface with the Internet and credit card service centers; and

a printer coupled to the CPU.

Patent owner argues that the references do not disclose charging users for terminal access (Br 17):

The Shah article does not disclose or suggest that a credit card swipe device should be employed to charge a user for use of the terminal. . . . Exhibits E and F were specifically directed to charging the user for use of the service, not for use of the terminal. Neither of these references contemplated the broader and more ingenious idea of allowing access to the Internet, and then charging the user for access to the terminal.

None of the references discloses or suggests charging users for terminal access. None of the references discloses or suggests the use of a credit card swipe device to access the Internet.

The Examiner responds that "claims 6-9 do not recite charging for terminal access" (EA9), but only "for use of the terminal." The Examiner states that "Exhibit E clearly teaches a credit card reader which accepts payment by a user for use of the terminal to carry out various services, e.g. facsimile communication, word processing, high-quality copying, fax mailbox service, electronic library access" (EA9).

We agree with the Examiner's interpretation that payment for services performed on the terminal is payment for use of the

terminal. The terms "pay-as-you-use" and "payment by a user for use of the terminal" are not defined in the claims or in the specification, as payment to get onto or access the terminal, and are broad enough to include payment for use of services conducted on the terminal. In claim 6, the "means for accessing the Internet" follows the limitation of accepting payment "for use of the terminal," and claim 6 does not expressly link payment for "use of the terminal" to "accessing the Internet." Payment for "use of the terminal" could be payment "for use of the terminal" to perform a different service, such as sending a facsimile, making a copy, printing a document on the claimed printer, etc.; i.e., claim 6 does not require payment for all uses of the terminal. The software for interfacing with the Internet and credit card service centers is for two different purposes and there is no express limitation of charging a credit card for access to the Internet. Nevertheless, to prevent controversy on claim interpretation, we interpret payment for "use of the terminal" to be payment for the service of accessing the Internet on the terminal.



Obviousness

Factual findings

Scope of the art

Patent Owner's disclosed field of endeavor appears to be best defined as pay-per-use public communication terminals, and the particular problem with which he was concerned in claim 6 was providing access to the Internet. Exhibits E and F relate to pay-for-use public communication terminals and are within the inventor's field of endeavor. Shah relates to providing Internet access in a public communications terminal and is in the field of public communications terminals and is at least pertinent to the problem of providing Internet access in a public terminal. There is no dispute that the references are within the scope of the prior art; i.e., that they are from analogous art. See In re Deminski, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986) (the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned); Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 1535, 218 USPQ 871, 876 (Fed. Cir. 1983) ("The scope of the prior art has been defined as that 'reasonably pertinent to the particular problem with which the inventor was involved'.").

Content of the references

Exhibit E discloses a free-standing pay-for-use TouchFax TF750 public communications terminal (kiosk) for locations such as airports, hotels, truck stops, and supermarkets (p. 48). Services include phone, fax, computer, word processing, copying, and information services. The TouchFax terminal has a microprocessor, a touch-screen monitor, a data port for modem and laptop connections, a full-size keyboard, and a laser printer (p. 49, left col.). "Payment for services is made using credit card or other magnetic card such as a telephone calling card. The terminal provides a detailed printed receipt of the transaction for expense account record keeping." (P. 49, left col.) The user can connect via a modem to the Official Airline Guide (OAG) database and receive a facsimile report (p. 49, right col.). Exhibit E states that "'The TouchFax is designed to emulate exactly what a person will be able to use in their homes,' says Massey" (p. 49).

Exhibit F discloses a "TF700 Public Communications Terminal from TouchFax," in a stand-alone housing including a telephone, speaker, touch-screen monitor, a credit card reader for payment of services, a full-sized keyboard for "computer database access or word processing," an option panel, a flatbed scanner, a 386 CPU, and a laser printer. Services include "telephone, send or

receive a fax, photocopying, word processing and laser printing, and access to a growing number of information databases from Wall Street news to international sports scores." Exhibits E and F essentially describe the same terminal, the differences being that the TF750 had a sloped countertop instead of the flat countertop in the TF700, and the TF750 had the keyboard in the countertop instead of a motorized retractable keyboard in the TF700. See Deposition of Daniel Toughey, President of TouchFax, in Civil Action No. 98-PT-596-E, pp. 55-59 (Exhibit 7 in deposition corresponds to Exhibit F in TouchFax protest and this appeal, and Exhibit 12 in deposition corresponds to Exhibit E in TouchFax protest and this appeal).

Shah discloses a kiosk-based information system using the World Wide Web on the Internet as an interface (abstract). Shah discloses that the advantages of using the Web are its popularity, it is already a multimedia tool, the user will have access to the many services on the Internet, and it is an accepted standard as opposed to a proprietary system (pp. 1-2). The kiosk includes input, output, processing, and network connection hardware, and Web browser software (p. 2 under "The Access Interface"). Shah states that entities that might implement a kiosk-based information system include "Commercial Information Referral organizations who wish to provide a paid

service through such kiosks" (page 3). Shah states (page 5):  
"Commercial organizations may also wish to charge customers for access to specific documents or services. The concept of registered users and billing may be built into the server."

#### Differences

The Examiner finds that one difference between the subject matter of claim 6 and Exhibit E is that Exhibit E does not expressly disclose software to allow interaction with credit card centers (FR6).

The Examiner finds that difference between the subject matter of claim 6 and the combination of Exhibits E and F is that Exhibits E and F do not specify accessing and interfacing with the Internet (FR6).

#### Level of ordinary skill in the art

Although examiners seldom make an express finding as to the level of ordinary skill in the art, the level of ordinary skill in the art is evidenced by the references. See In re Oelrich, 579 F.2d 86, 91, 198 USPQ 210, 214 (CCPA 1978) ("the PTO usually must evaluate both the scope and content of the prior art and the level of ordinary skill solely on the cold words of the literature"); In re GPAC Inc., 57 F.3d 1573, 1579, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995) (the Board did not err in adopting

the approach that the level of skill in the art was best determined by the references of record); Okajima v. Bourdeau, 261 F.3d 1350, 1355, 59 USPQ2d 1795, 1797 (Fed. Cir. 2001) ("[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error 'where the prior art itself reflects an appropriate level and a need for testimony is not shown.'"). Skill in the art is presumed. See In re Sovish, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

Objective evidence of nonobviousness

No objective evidence of nonobviousness has been presented.

Motivation

The Examiner finds that the communication software in Exhibit F suggests the use of communication software to communicate between the credit card reader device in Exhibit E and a credit card center.

The Examiner finds that Shah teaches the desirability of providing access to the Internet in a kiosk-based information system in order to provide users with the many services on the Internet (FR6).

Analysis

The claims stand or fall together with claim 6.

Patent owner argues that Exhibit E fails to disclose or suggest linking the facsimile kiosk with the Internet, and never discusses the Internet, much less accessing the Internet on a pay-as-you-go basis (Br12-14, Issue 3.A). It is argued that "Exhibit E does suggest that the kiosk may be used to access 'information databases,' but only in the context of receiving facsimile transmissions from these databases" (Br12) and, thus, Exhibit E lacks at least the claim limitation of "means for accessing the Internet." It is argued (Br13-15) that the Examiner errs in stating that Exhibit E teaches the limitation of "means for accessing commercial on-line services."

The Examiner responds that Shah is relied upon for its teaching of Internet access via a kiosk (EA8). The Examiner notes that "means for accessing commercial on-line services" does not appear in the Final Rejection (EA8).

Nonobviousness cannot be established by attacking the references individually where the rejection is based upon the teachings of a combination of references. See In re Merck & Co., 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986). That is, it is not persuasive to argue that Exhibits E and F do not teach Internet access when the rejection relies on Shah for this

feature, or to argue that Shah does not teach charging for use of the terminal services when Exhibits E and F are relied upon for this feature. Shah teaches, in 1994, providing Internet access from a public kiosk in order to give users access to the many services on the Internet. Shah suggests that consumers wanted access to the Internet for these services. One of ordinary skill in the art would have been motivated to provide Internet access as an additional pay-for-use service in the public kiosks of Exhibit E and F to achieve this advantage and consumer demand. Since Exhibits E and F have dates of 1992 and 1991, respectively, before the Internet became widely accessible, it is not surprising that they do not mention the Internet. However, technology is not static and it would be expected that the kiosks would be updated to incorporate improvements in technology, such as access to the Internet, that may not have been foreseen at the time. Exhibit E states that "'The TouchFax is designed to emulate exactly what a person will be able to use in their homes,' says Massey" (p. 49) and the application, as originally filed, acknowledges that home and business provided access to online service providers and the Internet; thus, there is a suggestion to modify the TouchFax to provide public online services and public Internet access as those features became common at home and business.

The Examiner did find that Exhibit E teaches "means for accessing commercial on-line services" in the first Office action of August 25, 1999, and the second Office action of June 11, 2001, but did not repeat it in the Final Rejection. It is the examiner's Final Rejection that is reviewed in an appeal under 35 U.S.C. § 134, see In re Webb, 916 F.2d 1553, 1556, 16 USPQ2d 1433, 1435 (Fed. Cir. 1990), but even if the statement had been in the Final Rejection and Examiner's Answer, it would not be reversible error unless it was critical to the merits of the rejection.

Patent owner argues (Br15, Issue 3.B): "Exhibit F fails to disclose, teach or suggest software installed into the CPU to allow interface with the internet and credit card service centers. . . . Furthermore, nothing in Exhibit F discloses, teaches, suggests, or even hints, that the facsimile kiosk is interconnected with the internet."

The Examiner responds that Shah is relied upon for its teaching of Internet access via a kiosk (EA8, two places). The Examiner states that Exhibit F discloses that "TouchNet network management software collects usage and billing data" and discloses a credit card reader allowing payment by major credit cards (EA8).



Neither Exhibit E nor Exhibit F expressly discloses software for interfacing with credit card service centers. Exhibit F states that "TouchNet™ network management software collects usage and billing data, monitors equipment status and uploads documents, software and video screens. This enables operators to remotely manage thousands of TouchFax terminals from one location." The "network management software" provides management functions and does not suggest communication with credit card centers. Nevertheless, we find that one of ordinary skill in the art of credit-card-based point-of-sale terminals at the time of the invention would have understood that connection of the credit card reader to a credit card center for authorization and charging is implied in both Exhibits E and F; indeed, we think that the average person was aware that credit card readers were connected to credit card centers for charge authorization. Patent Owner does not appear to contest that Exhibits E and F teach, or at least suggest to one skilled in the art, connection of the credit card reader device to a credit card center. As for connection to the Internet, the rejection is based on the combination with Shah, which teaches the use of Web browser software to provide access to the Internet. As discussed in connection with Exhibit E, nonobviousness cannot be established by attacking references individually where the rejection is based

upon a combination of references, and Shah would have motivated one skilled in the art to provide Internet access in a public kiosk environment.

Patent Owner argues that Shah does not teach the use of any software for interfacing with credit card service centers and there is no discussion regarding how a user would pay for the use of the kiosks (Br16). It is argued that the Examiner erred in relying on the commercial organizations at pages 3 and 5, because it is argued that "the commercial organizations' role with the kiosks is as an owner or the kiosk who charges users for the time display an advertisement" (Br16). It is argued (Br16-17):

The Shah article does not discuss the commercial organizations as providing any specific services, let alone charging for Internet access. Furthermore, nothing is disclosed in the Shah article regarding how these commercial organizations will be paid, let alone, the payment by credit card, at the physical location of the kiosk, utilizing software for interfacing with credit card service centers.

The Shaw article does not disclose or suggest that a credit card swipe device should be employed to charge a user for use of the terminal. The Shah article does not discuss the use of a credit card swipe device. It does not specify accessing and interfacing with the Internet.

The Examiner responds that Exhibit E provides a credit card reader to allow payment for services on the terminal (EA9).

Again, nonobviousness cannot be established by attacking references individually where the rejection is based upon a combination of references. We agree with the Examiner that

Exhibit E teaches payment for the use of terminal services using a credit card and credit card reader. Exhibit F also teaches these limitations. Shah states that entities that might implement a kiosk-based information system include "Commercial Information Referral organizations who wish to provide a paid service through such kiosks" (p. 3) and "Commercial organizations may also wish to charge customers for access to specific documents or services. The concept of registered users and billing may be built into the server" (p. 5). Shah does not teach how payment for documents or services would be made, which is why Exhibits E and F are cited.

Patent Owner argues that there is no motivation for the combination, generally citing case law that there must be a reason to combine references (Br10-12; Br17; Br19).

The Examiner repeats the obviousness reasoning (EA10-11).

We conclude that the Examiner has established a prima facie case of obviousness, including motivation for the combination. Patent Owner provides no reason why one skilled in the art would not have been motivated to provide Internet access in the public kiosk environment of Exhibits E and F given Shah's teaching of a public kiosk to allow users access to the many services available on the Internet.

Patent owner discusses European Patent EP 0486160 A2, published May 20, 1992 (Br 18-19, Issue 3.D). The European Patent was cited by the Examiner in the Notice of Defective Brief entered July 13, 2004, (page 3) as pertinent, but not relied upon, as showing a multi-purpose facsimile transmission terminal, which is said to correspond to the TouchFax terminal in the TouchFax article (Exhibit E) and the TouchFax brochure (Exhibit F).

Since the European Patent was not made part of the rejection, it cannot be considered. The statement of the rejection must expressly contain a mention of all references applied in the rejection. See In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970); Ex parte Movva, 31 USPQ2d 1027, 1028 n.1 (Bd. Pat. App. & Int. 1993). The European Patent describes that the terminal is "credit card activated" (col. 1, line 23; see also col. 3, lines 9-10) and describes that "the computer operating program provides a charge by selection, such as fax services, a charge by time used, a charge by the number of pages sent or received, and a charge for the class of telephone calls, whether local, long distance or international" (col. 5, lines 28-32). Although these might be useful additional teachings in the rejection, these teachings

cannot be attributed to or used to fill in any blanks in Exhibits E and F and the Shah article.

Patent owner refers to a statement by Mr. Greg Adank, acting Director of Information Management, Fort Leonard Wood, Missouri, and states that "Mr. Adank has provided an independent analysis of the three items of prior art (Exhibits E, F and I . . .)" (Br20) and "has also provided a straight forward matrix in his analysis that crosswalks the elements of the Appellant[']s claims and the prior art cited by the examiner" (Br20).

The Examiner responds that the statement is not in affidavit or declaration form and is not considered (EA10).

It is not apparent that Mr. Adank's statement adds anything to Patent Owner's arguments. Mr. Adank finds that the TouchFax exhibits do not teach access to online services or the Internet and the Shah article does not teach offering access to the Internet on a point-of-sale basis (p. 6). The Examiner's rejection admits this much. Mr. Adank's statement does not address the questions of motivation and obviousness.

Patent owner argues (Br20-21): (1) the invention provides an unexpected result, specifically a point-of-sale terminal to access the Internet; (2) it was a crowded art; (3) the references do not suggest the modification; (4) the references do not teach what the Examiner says they do, specifically point-of-sale

terminal to access the Internet; (5) the Examiner relies upon a strained interpretation that could only be made by hindsight, as demonstrated by the Examiner's refusal to consider the matrix provided by Mr. Adank; (6) the invention solves a different problem than the references; (7) the Examiner has not provided a convincing line of reasoning as to why the subject matter as a whole would have been obvious; (8) the references do not contain any express or implied suggestion to be combined; (9) it would be necessary to make modifications not taught by the prior art to combine the references in the manner suggested by the Examiner; and (10) that fact that three references must be combined is unequivocal evidence of nonobviousness.

The Examiner responds to (1) that Patent Owner fails to provide any evidence or facts in support of the argument (EA10), and to (10) that the number of references does not, without more, weight against the obviousness of the claimed invention, citing In re Gorman, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). The Examiner does not address the other points of argument.

We agree with the Examiner's response to (1). Mere allegations of "unexpected results" are not sufficient to show nonobviousness. An "unexpected result" is where the claimed invention achieves more than a combination which any or all of the prior art references suggested. We do not see how paying for

use of a terminal to access the Internet could ever provide an "unexpected result." We also agree with the Examiner's response to (10). Patent Owner's other arguments are token arguments and not persuasive. As to (2), Patent Owner has not demonstrated that it was a crowded art and, if so, how that should affect the obviousness analysis. As to (3), (4), (7), and (8), we find that the references do suggest the modification of adding Internet access to a pay-per-use public terminal. As to (5), it is not clear how the Examiner's refusal to consider Mr. Adank's statement can be considered evidence of hindsight; since we find motivation, the rejection is not based on hindsight. As to (6), Patent Owner has not explained how the problems are different, but, in any case, motivation in the prior art to combine the references does not have to be identical to that of the applicant to establish obviousness. See In re Dillon, 919 F.2d 688, 693, 16 USPQ2d 1897, 1901-02 (Fed. Cir. 1990) (en banc) (holding that an invention may be obvious for reasons the inventor did not contemplate) (overruling-in-part In re Wright, 848 F.2d 1216, 6 USPQ2d 1959 (Fed. Cir. 1988)). In addition, if Patent Owner's problem is defined as how to provide Internet access in a public terminal, this is the problem addressed by the combination of references. As to (9), Patent Owner has not said what other

modifications, not taught by the references and not discussed by the Examiner, are necessary to arrive at the claimed invention.

For the reasons stated above, we conclude that the Examiner has established a prima facie case of obviousness, which has not been shown to be in error. The rejection of claims 6-9 is sustained.

NEW GROUNDS OF REJECTION PURSUANT TO 37 CFR § 41.50(b)

In view of the importance of this case, as evidenced by the two civil actions resulting from the '905 patent and by the three protests, as well as the age of this reissue, we feel that new grounds of rejection are appropriate to put the best prior art on record in a rejection and, in particular, to provide an express teaching of paying for access to the Internet.

References

The following prior art is cited in support of a new ground of rejection.

TOUCHFAX AMERICA, video tape recorded May 14, 1993, and distributed by TouchFax Information Services as advertising at the May 1993 Comdex in Atlanta, Georgia,<sup>2</sup> © 1993 TouchFax Information Services, Inc., (Exhibit C to TouchNet Protest) (Artifact No. 09134831VA), including six printouts of frames from the video tape (Exhibit C, 1 to Exhibit C, 6) (Artifact No. 09134831CA).

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<sup>2</sup> See Deposition of Daniel Toughey in Mettke v. TouchNet, No. CV-98-PT-596-E, pp. 40-53, discussing Exhibit 5 to deposition.



TouchFax Network Topography Diagram, © 1991 TouchFax Information Systems, Inc. (Exhibit D to TouchNet Protest).<sup>3</sup>

Allen Weiner, TouchFax Provides the Ultimate In Place-Based Interactivity, Interactive World (October 1992), pp. 48-49 (Exhibit E to TouchNet Protest).<sup>4</sup>

VISION ... POWER ... VERSATILITY, F700 Public Communications Terminal brochure, TouchFax Information Systems, Inc. (© 1991) (Exhibit F to TouchNet Protest).<sup>5</sup>

Landis & Gyr, ISDN console, Public telephone and telematic console, available in 1988 (Exhibit C to Protest of Griffes Consulting SA) (hereinafter "L&G ISDN console").

Paul Gilster, The Internet Navigator (2d ed. John Wiley & Sons, Inc. 1994<sup>6</sup>), pp. 15-18, 24, 25, 56, 57, 195, 221-225 (hereinafter "Internet Navigator").

Andrew Cantor, Aliens Among Us, Internet World, Nov/Dec 1994, pp. cover, index (2 pages), 82-84 (hereinafter "Aliens").

On Haiti, Shooting From the Lip, Washington Post, October 6, 1994, from Lexis/Nexis (hereinafter "On Haiti").

We conclude that all references are prior art "printed publications." TouchFax Exhibit C through Exhibit F were publicly distributed as discussed in the deposition of Daniel Toughey, President of TouchFax (pages of deposition noted in footnotes). TouchFax Exhibits E and F were also previously

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<sup>3</sup> Id. at pp. 20-25, discussing Exhibit 3 to deposition.

<sup>4</sup> Id. at pp. 58-59, discussing Exhibit 12 to deposition.

<sup>5</sup> Id. at pp. 55-56, discussing Exhibit 7 to deposition.

<sup>6</sup> Published August 25, 1994, according to the copyright records at "<http://copyright.gov>."

discussed to be prior art. The L&G ISDN console brochure was publicly distributed as evidenced by the declaration of Adolf Deyhle (Exhibit E to Griffes Protest).

New grounds of rejection

Claim 9 is rejected under 35 U.S.C. § 112, fourth paragraph, as failing to further limit claim 6 from which it depends.

Claim 9 merely repeats all of the elements of claim 6.

Claims 6-9 are rejected under 35 U.S.C. § 103(a) as unpatentable over Exhibit C (including Exhibits C, 1 to C, 6), Exhibit D, Exhibit E, Exhibit F, L&G ISDN console, Internet Navigator, Aliens, and On Haiti, for reasons to be discussed.

Claim interpretation

We interpret "pay-as-you-use" and "payment by a user for use of the terminal" to require payment for use of the terminal to access the Internet.

Obviousness

Factual findings

Scope and content of the prior art

Scope

Patent Owner's field of endeavor appears to be best defined as pay-per-use public communication terminals, and the particular problem with which he was concerned was providing access to the Internet. Exhibits C, D, E, F, L&G ISDN console, and On Haiti relate to pay-for-use public communication terminals and are within the inventor's field of endeavor. The Internet Navigator and Aliens relate to on-line service providers and access to the Internet and are reasonably pertinent to the problem of providing Internet access. Thus, we find the references to be within the scope of the prior art.

Content

Exhibit C is a videotape recorded May 14, 1993, and distributed by TouchFax Information Services as advertising at the May 1993 Comdex trade show in Atlanta, Georgia. The video tape advertises the use of the TouchFax kiosks for a variety of purposes including pay-per-use access to the Prodigy online computer service provider and for connection to the Internet,

although no kiosks had been built to perform these functions.<sup>7</sup> Exhibit C, 1 is a printout of a video frame showing the opening title and production date of May 14, 1993. Exhibit C, 2 is a printout of a video frame showing a customer inserting a credit card into the TouchFax unit to activate the unit. Exhibit C, 3 is a printout of a video frame which specifically advertises connection to the Prodigy Information Service, a well-known online computer service provider in 1993. Exhibit C, 4 is a printout of a video frame which specifically advertises connection to the Internet. Exhibit C, 5 is a printout of a

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<sup>7</sup> See Deposition of Daniel Toughey in Civil Action No. 98-PT-596-E, pp. 44-45, indicating that video was a marketing tool, intended to show possible uses:

Q: (By Mr. Polasek [Attorney for Patent Owner]) Now that we have been able to stop the tape, it shows a rectangular gold block labled [sic] internet. I think it is right at -- I thought it was the 36 second mark. It may be 34.

MR. STITT [Attorney for Defendant]: It appears to be 34.

Q: (By Mr. Polasek) Did that provide for access to the internet? If the user was to touch that icon, I guess it what you would call it, that portion of the TouchNet screen, does that enable a user to gain internet access or do you know?

A: Not at that time, no. That was like MCI mail above it. Those are possible uses for the system. And so the reason we built this video was to sell our systems. And so, again, the vision of TouchFax, TouchNet was its multipurpose information communication terminal that, depending on what our customers, whoever owned these things wanted to provide, they could provide that type of information.

video frame showing a user at a TouchFax unit using the keyboard and showing the credit card reader device. Exhibit C, 2 is a printout of a video frame showing a second display of the Prodigy Information Service being offered and being advertised in the video tape as an online connection option.

Exhibit D is a diagram teaching use of a TF750 Public Terminal as a data and communications system. Exhibit D teaches a system which includes a "TouchFax Electronic Library" which serves as a "Gateway to Fax & Computer Services." The computer services include an "on-line interactive data base" including "CompuServe, Prodigy" online providers.

Exhibits E and F have been previously described.

The Internet Navigator describes that the Internet is a network of networks, which is made from computers and cables (p. 15). The Internet provides many different applications or services, such as e-mail (electronic mail), file transfer, and remote login (pp. 24-25). Commercial online services,<sup>8</sup> such as

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<sup>8</sup> "Online service provider" is defined in "http://en.wikipedia.org/wiki/Online\_service," where the original meaning is what applied in 1994:

An online service provider, in modern usage refers to an entity which provides a service online. It can include internet service providers and web sites, such as Wikipedia's or Usenet (commonly accessed through Google Groups). In its original more limited definition it referred only to a commercial computer communication service in which paid members could dial via a computer modem the service's private computer network and access various services and

CompuServe, were centralized as opposed to distributed like the Internet (pp. 17-18). "[C]ommercial providers such as CompuServe, GENie, and Prodigy have all made Internet mail access available" (p. 16; *see also*, pp. 57, 195; e-mail at pp. 221-225).

Thus, many online service providers, such as Prodigy, provided access to the Internet via e-mail. The World Wide Web (WWW) is a collection of documents linked by hyperlinks and URLs (pp. 388-396) and is a service that runs on the Internet.<sup>9</sup> The claims recite access to the Internet, not to the WWW, and are met by access to one service on the Internet, such as e-mail.

Aliens describes that online service providers such as America Online, CompuServe, GENie, and Prodigy were providing access to more features of the Internet in 1994. It is stated

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information resources such a bulletin boards, downloadable files and programs, news articles, chat rooms, and electronic mail services. The term "online service" was also used in references to these dial-up services. The traditional dial-up online service differed from the modern Internet service provider in that they provided a large degree of content that was only accessible by those who subscribed to the online service, while ISP mostly serves to provide access to the internet and generally provides little if any exclusive content of its own.

<sup>9</sup> "[T]he Internet and the World Wide Web are not synonymous: the Internet is a collection of interconnected computer networks, linked by copper wires, fiber-optic cables, wireless connections etc.; the Web is a collection of interconnected documents, linked by hyperlinks and URLs, and is accessible using the Internet. The Internet also provides many other services including e-mail, file sharing and others ...."  
"http://en.wikipedia.org/wiki/Internet."

that many of the services have offered e-mail gateways to the Internet for some time; e.g., "Like the other on-line services, CompuServe has offered an e-mail gateway to the Internet for some time" (p. 83); "GENie has been offering an e-mail gateway to and from the Internet for several years, but nothing more" (p. 84); "Prodigy already has an e-mail gateway to the Internet ..." (p. 84). This qualifies as "access to the Internet." Aliens also describes that online services have charged hourly fees for Internet services (p. 84).

L&G ISDN console describes a free-standing ISDN (Integrated Services Digital Network, an international standard for switched, digital dial-up telephone service for voice and data) payphone capable of accessing Videotex services available to the general public. Videotex was the first attempt at interactive information delivery for shopping, banking, news, etc. Videotex uses a box and keyboard associated with a video display. Data are delivered by phone line and stored in the box as predefined frames with limited graphics that are retrieved by menu.<sup>10</sup> The payphone has a telephone access node (required in a payphone); a credit card reader; a video display monitor; a keyboard; a modem (inherently required to connect to the Videotex service); means (software and hardware) to access commercial online Videotex

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<sup>10</sup> See "<http://en.wikipedia.org/wiki/Videotex>."

services; and must contain a microprocessor. "The Landis & Gyr ISDN console enables the public to obtain access to the usual services and sources of information and to new services, all via the same terminal." "For administration of calls made on credit, the Landis & Gyr console connects itself to a specific centralized system, in particular for the phases of authorization and, at the end of the session, for the collection of the relevant data." "[Videotex] services are selected by means of instructions entered via the keyboard using a syntax determined by well defined rules and the requested data are presented in the form of full pages in colour." No printer is disclosed.

On Haiti describes that "'Cyberia' -- a 'cyberspace cafe' -- has opened recently in central London offering coffee, cakes and connection to the Internet. Connect charge: 1.95 British pounds per half-hour." The computers for this cafe inherently must have a CPU, monitor, keyboard, modem, means for accessing the Internet and allowing user interaction, and software installed into the CPU to allow interface with the Internet. There must inherently be telephone access node to allow access to the Internet. Thus, On Haiti discloses payment for use of a terminal access to the Internet, but does not describe payment using a credit card, or a credit card reader swipe device connected to a credit card service center, and does not describe a printer.



Differences

The differences between the subject matter of independent claim 6 and the pay-for-use public TouchFax terminal of Exhibits E and F is that Exhibits E and F: (1) do not expressly disclose connecting to a credit card center; (2) do not disclose providing access to the Internet; and, so, (3) do not disclose charging for using the computer terminal to access to the Internet.

The differences between the subject matter of independent claim 6 and On Haiti are that On Haiti does not describe:

- (1) payment using a credit card via a credit card reader swipe device connected to a credit card service center; and
- (2) a printer.

Level of ordinary skill in the art

The level of ordinary skill in the art is evidenced by the references, as previously noted.

The references of record demonstrate that those of ordinary skill in the relevant arts knew: (1) pay-for-use public communications terminals providing for pay-for-use telephone, facsimile, computer, and communication services were well known, see Exhibits C-F and L&G ISDN console; (2) access to the Internet, at least to e-mail services on the Internet, was commonplace in 1994 and was provided by online service providers, such as CompuServe and Prodigy, see Internet Navigator and

Aliens; (3) online service providers were starting to provide access to more than e-mail services on the Internet in 1994, see Aliens; (4) charging for use of a public computer terminal to access the Internet was known, see On Haiti.

In addition, although not relied upon in this rejection, we note that Patent Owner's expert Mr. Adank described the knowledge of those of ordinary skill in the art in his "General Observations" (p. 1):

Typical home and business computers (Intel based 286/386 and other compatible class processors) were capable of performing all tasks and features described in your background description of prior art. Specifically, those systems were capable of sending and receiving faxes via internal or external modem, generating electronic documents and printing or faxing them to a remote terminal, communicate with on-line service providers (Prodigy, CompuServe, AOL), as well as to be used to communicate on the Internet via Internet service provider (ISP). The ability to couple a credit card reading device to a computer terminal was also common place during this time as many point-of-sale devices (i.e. cash registers) were in fact systems built from the core components found inside a computer terminal.

Objective evidence of nonobviousness

There is no objective evidence of nonobviousness.

Motivation

The motivation to combine any of the teachings of TouchFax Exhibits C, D, E, and F is that all exhibits are from the same corporation, TouchFax, and expressly teach modifications,

variations, and improvements to a pay-for-use public communications terminal. Thus, the teaching of Internet access in Exhibit C suggests modifying Exhibits E and F to provide Internet access, and the teaching on providing access to online service providers in Exhibit D suggests modifying Exhibits E and F to provide access to online service providers.

Since Exhibit C to Exhibit F disclose pay-for-use public terminals, this suggests payment for use of any service provided by the terminal, including services that may be added later.

L&G ISDN console teaches connection of a credit card reader to a credit card center for authorization and collection of credit card charges, which expressly provides motivation for connecting credit card readers to a credit card center, if proof of this common fact is needed.

Exhibit E states that "'The TouchFax is designed to emulate exactly what a person will be able to use in their homes,' says Massey" (p. 49), which suggests modification of the terminal to provide services on a public terminal as those services become common at home and business.

On Haiti discloses payment for use of a public terminal to access the Internet, which expressly provides motivation for charging for Internet access in other public terminals.

The Internet Navigator and Aliens teach that online service providers provided access to e-mail services on the Internet in 1994, which expressly suggests that any access to online service providers in 1994 would have provided access to the Internet.

Analysis

"[T]he test [for obviousness] is what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). "The question is whether it would have been obvious to one of ordinary skill in the art, working with the . . . [prior art] references before him, to do what the inventors herein have done . . . ." Id. at 425, 208 USPQ at 881-82. The collective teachings of the references do not depend on the order in which the references are modified. See In re Bush, 296 F.2d 491, 496, 131 USPQ 263, 267 (CCPA 1961) ("In a case of this type where a rejection is predicated on two references each containing pertinent disclosure which has been pointed out to the applicant, we deem it to be of no significance, but merely a matter of exposition, that the rejection is stated to be on A in view of B instead of on B in view of A, or to term one reference primary and the other secondary."). We have applied more than the minimum number of references needed to meet the claims in order to provide evidence of the level of ordinary skill in the

art and motivation, and to show different ways to approach the obviousness question.

We approach the obviousness issue from two directions. First, Exhibits E and F are selected as the main references because they describe the general pay-for-use public terminal described in the original application, and we then show why it would have been obvious to modify the terminal to provide for pay-for-use access to the Internet. Second, On Haiti describes payment for use of a computer terminal to access the Internet, but does not disclose payment using a credit card reader or a printer, and we explain why it would have been obvious to add a credit card reader and printer.

(1)

Exhibits E and F describe essentially the same pay-for-use public communications terminal providing services of receiving and sending facsimiles, word processing, copying, and printing. Although Exhibits E and F do not expressly teach that the terminal connects the credit card reader to a credit card service, one of ordinary skill in the art of credit-card-based point-of-sale terminals at the time of the invention would have understood that connection of the credit card reader to a credit card center for authorization and charging is implied in both Exhibits E and F; indeed, we think that the average person was

aware that credit card readers were connected to credit card centers for charge authorization. Patent Owner did not contest that Exhibits E and F teach this feature. Nevertheless, L&G ISDN console teaches a credit card reader in a public communications terminal, which communicates with a credit card service center ("For administration of calls made on credit, the Landis & Gyr console connects itself to a specific centralized system, in particular for the phases of authorization and, at the end of the session, for the collection of the relevant data.") and one skilled in the art would have been motivated to add a connection to the credit card center in Exhibits E and F to provide authorization of cards and collect amounts charged for communication services. Exhibits E and F disclose "causing the printer to print a receipt or any other document available from a commercial on-line service," as recited in claim 8, because Exhibit E discloses "terminal provides a detailed printed receipt of the transaction" and can print documents such as flight schedules from the OAG database, a commercial online service, and Exhibit F teaches a terminal with a printer and access to commercial databases. Claim 9 adds nothing to claim 6. Claim 7 remains rejected as lacking written description, but, nevertheless, Exhibits E and F and L&G ISDN console all show a keyboard that controls a computer.

There are at least three reasons why it would have been obvious to add access to the Internet as a pay-for-use feature on Exhibits E and F.

(1) (a)

Exhibit C (see Exhibit C, 4) expressly discloses that the TouchFax terminal can be built to provide access to the Internet. The fact that Exhibit C is a later improvement of the TouchFax terminal of Exhibits E and F, and is by the same corporation, provides the express suggestion to modify Exhibits E and F to provide access to the Internet. Exhibit C is not been applied as the main reference because it is easier to point to teachings in writings than in a video tape. Because Exhibits C, E, and F are pay-for-use public terminals, one skilled in the art would have been motivated to charge for access to all telephone, facsimile, and computer services, including an added computer service of access to the Internet.

(1) (b)

Exhibit D discloses that it was known to be able to connect the TouchFax pay-for-user terminal to online service providers, such as CompuServe and Prodigy, in 1991. The fact that Exhibits D, E, and F all relate to a TouchFax terminal by the same corporation provides the express suggestion to modify Exhibits E and F to provide access to online service providers.

Because Exhibits D, E, and F are pay-for-use public terminals, one skilled in the art would have been motivated to charge for access to all telephone, facsimile, and computer services, including an added computer service of access to an online service provider. The Internet Navigator and Aliens describe that online service providers were providing access to at least Internet e-mail by 1994, and Aliens describes that the trend among online service providers in 1994 was to provide access to more Internet features than just e-mail. Therefore, Internet Navigator and Aliens would have suggested to one skilled in the art at the time of the invention that the online service providers on the TouchFax terminal provided Internet access via e-mail or, at least, that providing Internet access would have been obvious modification. In addition, Exhibit E states that "'The TouchFax is designed to emulate exactly what a person will be able to use in their homes,' says Massey" (p. 49) and the application, as originally filed, acknowledges (as it must) that home and business provided access to online service providers and the Internet; thus, there is a suggestion to modify the TouchFax kiosk to provide communications services (e.g., online services and Internet access) in a public terminal as those features became common at home and business. Again, since the TouchFax terminal is a pay-for-use-of-services terminal, one skilled in



the art would have been motivated to charge for access to the online service provider which provides Internet access.

(1) (c)

On Haiti discloses charging for use of a public computer terminal to access to the Internet. One of ordinary skill in the art would have been motivated to add pay-for-use Internet access to the pay-for-use public terminals of Exhibits E and F because it merely adds an additional pay-for-use service.

(2)

On Haiti discloses charging for use of a public computer terminal which provides access to the Internet, but does not describe payment using a credit card, or using a credit card reader swipe device connected to a credit card service center, and does not describe a printer. One skilled in the art of credit card transactions would have been motivated to provide a credit card reader to allow users to charge their credit cards for the convenience of the service provider as well as the user in view of Exhibits E and F and the L&G ISDN console. Connection to a credit card center was so well known that its use is considered to be implied in Exhibits E and F, but, nevertheless, the L&G ISDN console expressly discloses connection to a credit card center for authorization and charging. One of ordinary skill in the art would have been motivated to provide a printer

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to the computer terminal in On Haiti because printers were used with computers to provide hard copy records of what was viewed, such as e-mails, and the use of printers with public computer terminals was known as evidenced by Exhibits E and F.

CONCLUSION

The rejection of claim 7 under 35 U.S.C. § 112, first paragraph, is sustained.

The rejection of claims 6-9 under 35 U.S.C. § 103(a) is sustained.

New grounds of rejection have been entered as to claim 9 under 35 U.S.C. § 112, fourth paragraph, and as to claims 6-9 under 35 U.S.C. § 103(a).

This decision contains new grounds of rejection pursuant to 37 CFR § 41.50(b) (2005). 37 CFR § 41.50(b) provides that "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (2004).

AFFIRMED - 37 CFR § 41.50 (b)

Lee E. Barrett  
LEE E. BARRETT

LEE E. BARRETT  
Administrative Patent Judge

*Jameson Lee*  
JAMESON LEE  
Administrative Patent Law

/JAMESON LEE  
Administrative Patent Judge

BOARD OF PATENT  
APPEALS  
AND  
INTERFERENCES

*Sally C. Medley*  
SALLY C. MEDLEY  
Administrative Patent Judge

SALLY C. MEDLEY  
Administrative Patent Judge

ATTACHMENTS:

- (1) Rawn Shah, Suggestions for Information Kiosk using the World Wide Web, <http://www.rtd.com/people/rawn/kiosk-paper.html> (April 30, 1994), download date 2/3/99, pp. 1-5 (Exhibit I to Protest by North Communications, Inc.)
- (2) The World Wide Web Conferences, 1994-1995 Kiosk Papers, <http://www.visi.com/~keefner/pdfs/twwwc.htm>, pp. 1-3 (of 113) (not prior art).
- (3) Black and white copies of Exhibits C,1 to C, 6, which are copies of frames from TOUCHFAX AMERICA, video tape recorded May 14, 1993.

- (4) TouchFax Network Topography Diagram, © 1991 TouchFax Information Systems, Inc. (Exhibit D to TouchNet Protest).
- (5) Allen Weiner, TouchFax Provides the Ultimate In Place-Based Interactivity, Interactive World (October 1992), pp. 48-49 (Exhibit E to TouchNet Protest).
- (6) VISION ... POWER ... VERSATILITY, F700 Public Communications Terminal brochure, TouchFax Information Systems, Inc. (© 1991) (Exhibit F to TouchNet Protest).
- (7) Landis & Gyr, ISDN console, Public telephone and telematic console, available in 1988 (Exhibit C to Protest of Griffes Consulting SA).
- (8) Paul Gilster, The Internet Navigator (2d ed., John Wiley & Sons, Inc. 1994), pp. 15-18, 24, 25, 56, 57, 195, 221-225.
- (9) Andrew Cantor, Aliens Among Us, Internet World, Nov/Dec 1994, pp. 82-84.
- (10) On Haiti, Shooting From the Lip, Washington Post, October 6, 1994, from Lexis/Nexis.
- (11) Statement by Gregory W. Adank received April 24, 2002.
- (12) Declaration of Adolf Deyhle (Exhibit E to Griffes Protest)
- (13) Deposition of Daniel Toughey in Mettke v. TouchNet Information Systems, Inc., No. CV-98-PT-0596-E (N.D. Ala. filed March 16, 1998), pp. 1-5, 20-25, and 40-59.
- (14) Background definitions from wikipedia.org (not prior art)  
  
Internet: "<http://en.wikipedia.org/wiki/Internet>," p. 1/10.  
Online service provider: "[http://en.wikipedia.org/wiki/Online\\_service](http://en.wikipedia.org/wiki/Online_service)," 2 pages.  
Videotex: "<http://en.wikipedia.org/wiki/Videotex>." 4 pages.

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